

REMARKS

Applicant first notes that the Examiner renumbered claims 18-24 of the Preliminary Amendment as 20-26 because claims 18 and 19 already existed. In light of this renumbering, Applicant has amended claims 22, 24 and 26 so that they depend from the proper claims as renumbered. Applicant inadvertently counted the number of claims incorrectly in the Preliminary Amendment. Thus, Applicant has paid for two additional claims in this Amendment.

The Examiner rejected claim 3 under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification. The Examiner rejected claims 1, 2, 5, 9 and 21-26 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 4 of US Patent 5,696,496. The Examiner rejected claims 6-8 and 10-13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of US Patent 5,696,496 in view of Mital (US Patent 5,664,228). The Examiner rejected claims 5-8 under 35 U.S.C. 103(a) as being unpatentable over Greenspan (US Patent 5,459,702), Rindfuss (US Patent 4,841,387) and Mital. The Examiner rejected claims 9-13 under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (US Patent 5,008,854), Yokozawa (US Patent 4,534,012) and Mital. The Examiner rejected claims 14-20 under 35 U.S.C. 103(a) as being unpatentable over Maeda et al., Yokozawa, Mital and Vanden Heuvel (US Patent 5,281,962).

Applicant's invention is a personal organizer and messaging device which is handheld and sized to fit substantially within a shirt pocket. The small size and high functionality provides substantial benefits. The device may include a variety of the following: audio input means for receiving and recording an audio message and generating a representative audio message signal; memory means for storing said audio message signal; processor means for controlling the receipt of said audio message signal, storing said audio message signal, and non-sequentially selectively recalling said audio message signal; audio output means for receiving said non

sequentially selectively recalled audio message signal and for playing back said non-sequentially selectively recalled audio message; writing means in the form of a touch panel for receiving a plurality of written messages and generating written message signals; display means positioned beneath said writing means for receiving and displaying the non-sequentially and selectively recalled written message through said writing means; a handheld housing for carrying the writing means, audio input means, the memory means, the processor means, the audio output means and display means; whereby the non-sequential selective recall of an audio message is accomplished by engagement with the touch panel; and a portable station including an auxiliary display with the portable station in selective engagement with the handheld unit and allowing transfer of information between the station and unit.

The Examiner objected to claims 1, 2 and 13 due the informality that the term "shirt porket" needed to be changed to "shirt pocket" to correct a typographical error. Applicant has examined said claims, is unable to find said informality and has therefore made no amendment with regard thereto.

The Examiner rejected claim 3 under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification. Applicant has amended claim 3 to add a portable station and to include the limitations of original claim 2, which introduce the "housing" – of the portable station, not the handheld unit -- to which claim 3 was intended to refer, but which had not been previously amended in light of the amendment of claim 2 in the Preliminary Amendment. Applicant submits this amendment overcomes the rejection.

The Examiner rejected claims 1, 2, 5, 9 and 21-26 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 4 of US Patent 5,696,496. The Examiner also rejected claims 6-8 and 10-13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of US Patent 5,696,496 in view of Mital (US Patent 5,664,228). Applicant has attached a terminal disclaimer to overcome these rejections and submits that the double patenting rejections of claims 1, 2, 5-13 and

21-26 should therefore be withdrawn. Applicant further notes that claims 1, 7, 11 and 13 have been amended to correct respective typographical errors therein.

As noted above, the Examiner rejected claims 5-8 under 35 U.S.C. 103(a) as being unpatentable over Greenspan (US Patent 5,459,702), Rindfuss (US Patent 4,841,387) and Mital. The Examiner also rejected claims 9-13 under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (US Patent 5,008,854), Yokozawa (US Patent 4,534,012) and Mital. The Examiner further rejected claims 14-20 under 35 U.S.C. 103(a) as being unpatentable over Maeda et al., Yokozawa, Mital and Vanden Heuvel (US Patent 5,281,962).

The Examiner initially has the burden of factually supporting a *prima facie* conclusion of obviousness, which then shifts the burden of providing evidence for arguments to the Applicant who may submit additional evidence of non-obviousness in order to overcome the Examiner's rejection. MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation to combine the references, the three possible sources of which are the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. MPEP 2143.01, citing In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998). Second, there must be a reasonable expectation of success in combining the references in order for it to be proper to combine them. MPEP 2143.02, citing In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03, citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The rationale to modify or combine prior art references may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of the ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. MPEP 2144, citing, for example In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles

or legal precedence that some advantage or expected beneficial result would have been produced by their combination. MPEP 2144, citing *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983).

As noted above, the Examiner rejected claims 5-8 under 35 U.S.C. 103(a) as being unpatentable over Greenspan (US Patent 5,459,702), Rindfuss (US Patent 4,841,387) and Mital (US Patent 5,664,228).

Applicant first notes that the present application is a continuation-in-part of patent application Ser. No. 08/950,212, filed Oct. 14, 1997, which is a continuation of U.S. Pat. No. 5,696,496 issued Dec. 9, 1997, which is a continuation of U.S. Pat. No. 5,648,760 issued Jul. 15, 1997, which is a continuation of Ser. No. 805,302, filed Dec. 10, 1991, abandoned. Claim 5 is supported by the parent application filed December 10, 1991 and thus predates Greenspan, which issued October 17, 1995. Applicant therefore submits that Greenspan is not prior art and that claim 5 is therefore allowable and that claims 6-8 are allowable as depending from an allowable claim.

Even if the Examiner finds that Greenspan is prior art, Applicant submits that claims 5-8 are allowable for other reasons discussed below.

Greenspan teaches an apparatus for improving the quality of recorded dictation in moving vehicles and thus primarily focuses on the elimination of "uncontrollable" ambient noise typically heard in moving vehicles. The Greenspan invention includes a handheld microphone unit 54 having a recording microphone 56 and is capable of playing recorded messages. In short, Greenspan teaches an improved dictation device and thus relates to audio inputs and outputs only and therefore fails to teach or suggest a writing means or the use of written messages in any form or fashion.

Rindfuss teaches a device for recording audio or video information and indexing handwritten notations to the recorded information, whereby the recorded information may be retrieved by using coordinates associated with the handwritten notations to locate and play back the recorded information. Thus, the Rindfuss device is inseparable from the use of handwritten notations. In addition, the

Rindfuss device is similar in its general configuration to a standard clipboard and teaches a touchpad 20 on which standard writing paper is positioned while making the handwritten notations on said paper. Such paper requires a relatively large surface area and thus requires a relatively large touchpad so that the device would not fit within a shirt pocket and would not be suitable in many circumstances.

Thus, Rindfuss requires the use of a writing means, touchpad 20, in order for the invention to function for its intended purpose -- without the handwritten notations, there would be nothing to index to the recorded information nor any reason to do so. Therefore, combining Rindfuss with any reference would require the inclusion of the touchpad. As noted above, Greenspan fails to teach or suggest any motivation for the inclusion of such a writing means and Applicant submits that there is therefore no motivation to combine the two references.

If anything, Greenspan teaches away from the combination. Inclusion of a writing means on device 54 of Greenspan would lead to a dangerous usage thereof during vehicle travel, distracting the driver and requiring the driver to take his or her hands off the steering wheel. As noted in Greenspan, the location of the microphone 56 in the vehicle (Fig. 6) is important for safety, obviously to prevent distracting the driver and keep the driver's eyes on the road as much as possible (Col. 8, lines 40-55). In addition, the relatively large touchpad 20 required by Rindfuss would not be suitable for use in a moving vehicle in the positions suggested by Greenspan, being generally too cumbersome and tending to interfere with visibility and/or safe driving movements. Thus, Greenspan teaches away from combination with Rindfuss. Applicant submits for the above reasons that Grennspan and Rindfuss cannot be properly combined and that the rejection of claims 5-8 should therefore be withdrawn. Further argument regarding the rejection of claims 5-8 follow.

Mital teaches a portable information device (PID) 30 (Fig. 1) or 104 (Fig. 4) which is configured to fit into the standard drive of a computer, such as a 3.5" disk drive (PID 30) or a PCMCIA port (PID 104). Mital teaches input means in the form

of a key pad 32 or 106. Alternately, display 34 may be a touch screen LCD (liquid crystal display) for inputting information via point contact with the LCD.

As noted above, Rindfuss requires the use of touchpad 20 in order for the invention to function for its intended purpose, and must permit the use of handwritten notations. In order for the use of handwritten notations to be feasible, such a touchpad must be sufficiently large, which is why the Rindfuss device accommodates a standard piece of paper. Thus, it would not be suitable to incorporate the very small display 34 of Mital into the Rindfuss device because this small space would not be suitable to allow the Rindfuss device to function properly. On the other hand, incorporating into the Mital device a touchpad like touchpad 20 of Rindfuss which is sufficiently large enough for such handwritten notes would be contrary to use with PID 30 or 104 of Mital because the increased size of the Rindfuss touchpad would not allow either of these PIDS to fit into their respective computer drives. Thus, Rindfuss and Mital each teach away from combination with one another. For all the above reasons, Applicant submits that the various references may not be properly combined and that the rejection of claims 5-8 should be withdrawn.

Inasmuch as Greenspan is not prior art with regard to claim 5 and the various references cited above either teach away from one another or fail to suggest a motivation for the combination thereof, Applicant submits that the cited references may not be properly combined and that therefore Applicant's invention is patentable over said references.

The Examiner rejected claims 9-13 under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (US Patent 5,008,854), Yokozawa (US Patent 4,534,012) and Mital.

Maeda et al. teach a pocket size data storage apparatus with a tablet device for inputting image data and a display section of a dot matrix type. The tablet device is made of transparent members and mounted on the display section as a unit. Image data is input from the tablet device and displayed on the display section. Character data input via character keys can be displayed with the image

data. Character and image data are related to one another as a pair of data and are stored.

Yokozawa teach a portable programmable information device and external programming station which selectively communicate with one another. The device includes input via keys 28, which also serve to retrieve stored information, which may be displayed on display.

Claim 9 has been amended to include the limitations "audio input means for receiving and recording an audio message; and playback means for playing back said audio message". As discussed above, Maeda et al. teach input means only for image and character inputs and nothing in said reference discusses the possibility or desirability of using an auditory input. Similarly, Yokozawa fails to teach or suggest the limitations of amended claim 9, also teaching input means only for character inputs. Therefore, Maeda et al. and Yokozawa each fail to teach or suggest an audio input means or playback means for playing an audio message, and thus neither reference is applicable to the device as claimed in amended claim 9. Applicant thus submits that claim 9 as amended is allowable and that claims 10-12 are allowable as depending from an allowable claim.

Claim 13 has been amended to recite in part "input means for receiving a first user inputted message in an auditory format". Applicant submits that Maeda et al. fails to teach or suggest an input means for an auditory input message. As discussed above, Maeda et al. and Yokozawa each teach input means only for image and character inputs and Applicant thus submits that claim 13 as amended is allowable as discussed with regard to claim 9.

Inasmuch as Applicant's invention includes input means for inputting an auditory message and playback means for playing back the auditory message, Applicant submits that the Applicant's invention is patentably distinct over the cited references.

The Examiner rejected claims 14-20 under 35 U.S.C. 103(a) as being unpatentable over Maeda et al., Yokozawa, Mital and Vanden Heuvel (US Patent 5,281,962). As discussed above, Applicant submits that claim 13 as amended is

allowable. Thus, Applicant submits that 14-19 are allowable as depending from allowable claim 13. Claim 18 has been amended to correct a typographical error. Applicant submits that the claim 20 is not properly rejected, as the Examiner has failed to point out the rationale for said rejection. Claim 20 depends from claim 1, as opposed to claim 13, and Applicant respectfully suggests that the rejection of claim 20 along with claims 13-19 may have been an inadvertent oversight by the Examiner. Applicant believes this to be the case, as there is no indication that claim 1 is rejected by the references cited in this paragraph (nor should the claim 1 limitations be so rejected). Therefore, Applicant submits that claim 20 cannot be properly rejected, because the limitations of claim 1 from which it depends have not and cannot be rejected via said cited references.

In light of the above discussion and amendments, Applicant submits that claims 1-26 are allowable over the cited references.

In view of the foregoing, the Applicant respectfully requests reconsideration of the claims and most earnestly solicits the issuance of a formal notice of allowability for the claims. Please call the undersigned attorney if any questions remain after this amendment.

Respectfully submitted at Canton, Ohio this 28th day of October, 2004.

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